



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#4

In re Application of: Robert J. Fitzsimmons
Serial No.: 10/080,642
Filing Date: February 22, 2002
Group Art Unit: Not Yet Assigned
Examiner: Not Yet Assigned
Title: STIMULATING CELL RECEPTOR ACTIVITY USING
ELECTROMAGNETIC FIELDS

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

PETITION TO MAKE APPLICATION FOR PATENT ON BEHALF
OF AN INVENTOR PURSUANT TO 37 C.F.R. § 1.47(B)

1. Orthofix Inc. (hereinafter "Orthofix") hereby petitions the United States Patent and Trademark Office (hereinafter "USPTO") to make application for patent, with regard to the above-identified patent application, on behalf of Robert J. Fitzsimmons, the inventor of the subject matter of the above-identified patent application (hereinafter "Inventor").

2. Orthofix is entitled to make application for patent on behalf of the Inventor because Orthofix currently jointly owns the subject matter of the above-identified patent application with the Inventor. On January 15, 1999, the Inventor signed a Research Agreement with Orthofix which states that Orthofix and the Inventor will have complete right, title, and interest in all patent applications and patents developed under the Research Agreement. The Research Agreement (with irrelevant portions redacted) is attached hereto as Exhibit A. The Inventor conceived of the subject matter of the above-identified patent application during research conducted under the terms of the Research Agreement. Accordingly, Orthofix jointly owns the subject matter of the above-identified patent application.

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OFFICE OF PETITIONS

Accordingly, Orthofix jointly owns the subject matter of the above-identified patent application.

3. The Inventor has failed to cooperate with the execution of the application papers. Orthofix has used diligent efforts to obtain the Inventor's cooperation with the filing of the patent application, which was filed on February 22, 2002. Before the filing of the patent application, Orthofix and its attorneys attempted to obtain the Inventor's review of the patent application, but were unsuccessful. Because of the impending loss of patent rights, Orthofix authorized the filing of the current application on February 22, 2002, without the Inventor's review of the application. On February 25, 2002, Orthofix's attorneys e-mailed a copy of the filed patent application to the Inventor for review and also e-mailed a Declaration and an Assignment to the Inventor for execution, but the Inventor did not respond to the e-mail. A copy of this e-mail to the Inventor is attached as Exhibit B. On April 18, 2002, Orthofix's attorneys sent the Inventor a package containing a cover letter, another copy of the patent application as filed, the Declaration, and the Assignment using U.S. Postal Service certified mail. A copy of the cover letter is attached as Exhibit C, and a copy of the certified mail receipt is attached as Exhibit D. Although the Inventor received and signed for the certified mail package, the Inventor has not responded to Orthofix or its attorneys. A copy of the returned postcard evidencing the Inventor's receipt of the certified mail package is attached as Exhibit E. Thus, Orthofix has used diligent efforts to obtain the Inventor's cooperation to no avail and, therefore, desires to continue the prosecution of the patent application without the Inventor.

4. Allowing Orthofix to continue the prosecution of the patent application would preserve the rights of Orthofix and the Inventor. Orthofix believes the subject matter in the patent application has technical merit and, hence, that the present patent application would be a valuable asset to Orthofix upon issuance. Thus, Orthofix will vigorously prosecute the patent application, which will enhance the prospect of those rights being awarded. Moreover, not allowing Orthofix to go forward with the patent application may result in a loss of patent rights due to the loss of the filing date of Provisional Application No. 60/271,030, filed

February 23, 2001, to which this patent application claims priority. Accordingly, allowing Orthofix to prosecute the patent application on behalf of the Inventor would preserve the rights of Orthofix and the Inventor.

5. If the USPTO wishes to contact the Inventor regarding any of these matters, his last known mailing address is:

1700 Encanto Lane
Colton, California 92324

His last known electronic mail address is biocore1@aol.com.


6. In summary, Orthofix jointly owns the subject matter of the patent application with the Inventor, has used diligent efforts to obtain the Inventor's cooperation to no avail, and would preserve the rights of the Inventor and Orthofix by prosecuting the patent application. Thus, Orthofix has met all the requirements of 37 C.F.R. § 1.47(b) for making application for patent on behalf of the Inventor and hereby petitions the USPTO for such capacity.

7. Accompanying this petition are:

- a. Exhibits A through E;
- b. A Declaration and Power of Attorney signed by Orthofix pursuant to 37 C.F.R. § 1.47(b);
- c. A Declaration of Brian W. Oaks in Support of Petition Pursuant to 37 C.F.R. § 1.47(b); and
- d. The petition fee of \$130.00 pursuant to 37 C.F.R. §1.17(i). The Commissioner is hereby authorized to charge any fees and credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

8. If additional clarification or evidence is required, please contact the below-listed attorney for Orthofix at your earliest convenience. It is respectfully requested that this Petition be granted.

Respectfully submitted,
BAKER BOTTS L.L.P.
Attorneys for Applicants



Brian W. Oaks
Reg. No. 44,981

Date: May 24, 2002

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